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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,172	05/19/1999	HIROKI KANNO	016907/0967	4798

7590 03/13/2003

FOLEY & LARDNER  
SUITE 500  
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WASHINGTON, DC 200075109

EXAMINER
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NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/314,172

Applicant(s)

KANNO ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on preliminary amendment filed on December.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on December 20, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/314,772 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uda (US Patent No. 5,822,507) in view of r Aoyama (US Patent No. 5,361,141)..

Concerning claims 1 and 18, Uda discloses an image forming apparatus (Fig.1) comprising reading means (103a-b) for reading a document and providing a first image data; image processing means (102); image forming means (104a-d) for forming an image on an image formation medium; image formation condition-producing means (107) for producing a second image indicative of operating conditions which are those of at least one of the reading means, the image processing means and the image forming means which determine image quality; means for controlling the image forming means (101) to form the first image from the

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second image formation condition on the image formation medium (Figs.1-6, 14-20; Abstract; col. 2, lines 35-49; col. 3, line 35 - col. 5, line 17).

Uda fails to teach a synthesizing means for synthesizing the first image data with the second image data and the image forming means form an image corresponding to the first and second image data. Aoyama discloses an image forming apparatus (Fig.2) comprising reading means (25) for providing a first image data, image processing means (26), image forming means (19, 27), operating condition image producing means (15) for producing a second image data (editing instructions); synthesizing means for synthesizing the first image data with the second image data; means (11) for controlling the image forming means 19 to form an image corresponding to the first and second image data (Figs.1b, 3; col. 4, line 39 – col. 6, line 7, col. 6, line 55 – col. 7, line 39). Aoyama further teaches that the second image data (editing instructions) determine image quality (col. 1, line 9 – col. 3, line 20). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of synthesizing the first image and the second image and form an image corresponding to the first and second image data taught in Aoyama to the system in Uda since both of them teach the second image data is for determining, enhancing and correcting the image quality of the first image.

Concerning claims 2-7, Uda further teaches that the image formation condition-producing means includes means for producing a character image, a pattern code (Fig.20); means for producing an image indicative conditions of the reading means or image forming means or of the image processing means; means for forming an image indicative of a resolution, a sampling rate of the reading means (Figs.3-6, 14-20; col. 1, lines 58 - col. 2, line 22; col. 6, line 41 - col. 7, line

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28; col. 10, line 32 - col. 11, line 21; col. 12, lines 31 - col. 15, line 21; col. 18, lines 25-63; col. 20, lines 8-25; col. 20, lines 8-54).

Concerning claim 9, Aoyama further teaches a designating means (16, 22) for designating whether or not the first image data should be synthesized with the second image data and the synthesizing means synthesizes the first image data and the second image data in a case where the designating means designates synthesis, and provides only the first image data in other cases (Figs.3).

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Monty et al (pub. No. US2001/0019416) discloses a method for specifying image file processing operations via device controls and a user-completed proof sheet.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

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A handwritten signature in black ink, appearing to read "Madeleine AV Nguyen". The signature is fluid and cursive, with the first name "Madeleine" written in a larger, more prominent script than the last name "Nguyen".

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622

AV  
March 10, 2003